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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,379	11/02/2000	Fred Bishop	10655.7600	4909
20322	7590	05/10/2005	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/704,379	BISHOP ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAGDISH PATEL	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-10, 15, 16, 21-25, 34-42, 47, 48 and 53-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10, 15-16, 21-25, 34-42, 47, 48, 53-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

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#### **DETAILED ACTION**

1. This communication is in response to amendment filed 2/16/2005.

#### ***Response to Amendment***

2. claims 6, 25, 38 and 57 have been amended. Claims 2-10, 15-16, 21-25, 34-42, 47, 48, 53-58 are currently pending.

#### ***Response to Arguments***

3. Applicant's arguments filed 2/16/05 have been fully considered but they are not persuasive. The shipping agents referred to in Shavit are connected to the users (buyers and sellers) via the IMM (Interactive Market Manager) which is an electronic hub. In order to interact electronically with the system 50 depicted in Shavit the participants must electronically communicate to each other via IMM. Therefore, the shipping agent is not merely a human entity but on that comprises electronic functionality to carryout functionality of providing goods and services to the parties involved in the commercial transaction. In other words the Shipping agent as recited the amended claim is not functionally and therefore patentably distinct from the shipping agent (i.e. associated interactive function) of Shavit. In view of this analysis and further in view of the defective claims as analyzed below the claims are rejected as being obvious over Walker in view of Shavit.

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-10, 15-16, 19, 21-25, 34-42, 47,48 and 53-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Independent claims 6, 25,38 and 57 recite "shipping agent configured to provide at least one of the goods, services and other items of value from said second party to said first party". However, none of other limitations have any functional relationship to the functionality of the shipping agent. In other words, the financial transactions are carried out in absence of the functions carried out by the shipping agent.

Since, the limitation containing shipping agent have no role in the balance of the claimed invention, the scope of the amended claims cannot be determined in terms of the functionality of the shipping agent as relates to the remaining functions or elements recited in the respective claims.

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Note also that the limitation "shipping agent configured to provide" goods, services and other items of value from a first party to a second party cannot be considered as a software agent, since, software cannot provide goods or services from one party to the other since the parties are presumably human entities or institutions participating in the commercial transaction process.

In view of the deficiencies present in the amended claims as per foregoing analysis, the claims have been rejected under new ground of rejection and the action is made a final rejection.

***Claim Rejections - 35 USC § 103***

6. Claims 6-10, 15-16, 19, 21-25, 34-42, 47,48 and 53-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and further in view of Shavit et al. (US 4,799,156) (Shavit).

As per claim 6, Walker teaches a method of facilitating commercial transactions, which method comprises the steps of:

registering at least one of a first party and a second party with a transaction mechanism having a financial account identifier for identifying a financial account associated with said first party;

(see col. 8 L 66 - col. 9 L 5; col. 13 L 1-10 and Fig. 5; see col. 15 L 46+ CPO)

receiving from at least one of said first party and said second party least one of a request to debit a financial account

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of said first party to effectuate a transaction between said first party and said second party;

(col. 9 L 32-43, funds transfer)

receiving from at least one of said first party and said second party transaction information relating to said transaction between said first party and said second party;

(buyer creates a CPO, see col. 8 L 66 - col. 9 L 5)

determining whether said transaction is acceptable based upon at least one of said transaction information between said first party and said second party;

(see Fig. 6, col. 17 L 27-47, see col. 22 "Delayed Payment Embodiment")

debiting funds form financial account of said first party;

(see col. 22 "Delayed Payment Embodiment")

disbursing funds to a financial account associated with said second party;

(see col. 22 "Delayed Payment Embodiment")

crediting said funds to said financial account associated with said second party.

(see col. 22 "Delayed Payment Embodiment")

Walker fails to teach the step of providing a shipping agent configured to provide goods, services, and other items of value from said second party to said first party.

Shavit, in the same field of endeavor teaches a method of electronically facilitating commercial transactions. Shavit teaches providing a shipping agent (freight services) configured provide at least one of goods, services, and at least other items of value from said second party (suppliers) (see Figure 2 and col. 5-6) to said first party (buyers).

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It would have been obvious to one of ordinary skill in the art at the time of invention to modify Walker as per Shavit to provide a shipping agent as claimed because it would provide facilitate communication for shipment of goods once the purchase conditions are met, thereby improving speed of shipment.

Please refer to prior office action for detailed analysis of claims 2-5, 7-10, 15 and 16.

Claim 19. wherein the step of providing a shipping agent comprises maintaining by said transaction mechanism at least one of said first party's and said second party's identity and address in confidence with respect to either said first or said second party.

(refer to Walker "Delayed Payment Embodiment", col. 22, note that the payment is carried out by the central controller who acts as an escrow agent).

Refer to claim 6 for motivation statement.

Claim 51 has been analyzed per corresponding method claim 19.

Claims 21-25 have been analyzed as per respective method claims 2-6. All limitations have been recited in the cited reference.

Claims 34-42 have been analyzed as per respective method claims 2-10. All limitations have been recited in the cited reference.

Claims 47-48 have been analyzed as per respective method claims 15 and 16. All limitations have been recited in the cited reference.

Claims 53, 57 and 58 have been analyzed as per respective method claims 2, 4 and 5. For hardware elements of the device please refer to Figures 2-4.

Claim 54: network interface in communication with said central processor (see Figure 2).

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Claim 55: storage device ..customer transaction records database.. (see Fig. 2 Buyer database).

Claims 56: said memory comprises a risk management module, transaction control module and an authentication module (see data storage device 250 having contract detail database 280, cryptographic key database 290 and CPO database which is accessible by CPU 205)

### **Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **Conclusion**



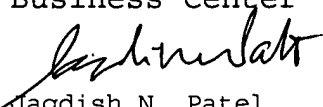
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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

5/3/05